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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,527	10/27/2005	Sebastien Rose	CEPF-0007	1480

23377 7590 10/02/2006  
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EXAMINER

PARSA, JAFAR F

ART UNIT PAPER NUMBER

1621

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/541,527	<b>Applicant(s)</b> ROSE ET AL.	
	<b>Examiner</b> Jafar Parsa	<b>Art Unit</b> 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10/27/2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,14-21 and 25-31 is/are rejected.
- 7) ☐ Claim(s) 3-13 and 22-24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/15/2006</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

Regarding claim 17, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

### ***Specification***

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 2, 14-21, 25-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boschelli et al (USPN 5,571,825) in view of Brannigan et al (USPN 4,964,893) and further in view of Lafon (US 4,177,290).

Boschelli teaches a process for preparing methyldiphenylmethylthioacetate by reacting benzhydrol with methyl thioglycolate. The preferred reaction conditions include the use of a catalytic amount of p-toluenesulfonic acid in toluene in the presence of activated molecular sieves. Alternatively, the suitably substituted benzhydrol and methyl thioglycolate are reacted in methanolic HCl. In some situations, the compounds can be prepared via the corresponding carboxylic acid. Addition of thioglycolic acid to the suitable benzhydryl halide in toluene with a catalytic amount of p.-toluenesulfonic acid in the presence of activated molecular sieves provides the intermediate acid. The acid is then esterified with acidic methanol to provide the compounds of the present invention. See col. 7-10 and Examples 1-2.

Boschelli does not teach oxidizing methyldiphenylmethylthioacetate to obtain methyl 2-diphenylmethylsulfinylacetate. However, brannnigan teaches the oxidation of ethyldiphenylmethylthioacetate to ethyl 2-diphenylmethylsulfinylacetate, which is a homolog of a methyl 2-diphenylmethylsulfinylacetate. See col. 21, methods "N" and "O" and table 1, compounds 45, 54 and 61. The claimed invention would have been obvious to the skilled artisan because close structural similarity of the reference compound suggests the claimed compound. One skilled in the art would expect the two compounds to have similar properties.

The references cited above do not teach a process for preparing modafinil (benzhydrylsulphinylnacetamide) using benzhydrylthioacetic acid. However, Lafon teaches a process for preparing modafinil using benzhydrylthioacetic acid. See example 1a. It would therefore have been obvious to one of ordinary skill in the art at the time the invention was made to obtain an acetamide derivative, such as modafinil

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which is known to have a useful pharmaceutical activity on the central nervous system as suggested by Lafon.

Claims 3-13 and 22-24 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of record neither teaches nor suggests reacting benzhydrol and an acid anhydride in the presence of an organic acid and in an appropriate solvent to prepare methyldiphenylmethylthioacetate.

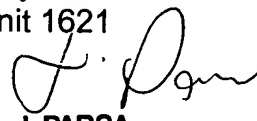
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jafar Parsa whose telephone number is (571)272-0643. The examiner can normally be reached on 8 a.m.-4:30 p.m. (M-F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JP  
September 22, 2006

Jafar Parsa  
Primary Examiner  
Art Unit 1621



J. PARSA  
PRIMARY EXAMINER